

REMARKS

Claim 2 is cancelled. Claims 4-7, 9-13, and 15 are currently amended. Claim 16 is new. Claims 4-13, 15, and 16 are currently pending.

Claims 4-7, 9-13, and 15 are currently amended to reflect the addition of claim 16. The current amendments do not introduce new matter. Reconsideration of the application in view of the current claims is respectfully requested and further in view of the following Remarks.

I. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Examiner refers to claim 1, which has been previously cancelled. The claim Examiner refers to reflect the language of pending claim 16. Applicants refer to claim 16 in reference to rejections by Examiner regarding claim 1.

A. Claims 2, 4-6, 8 and 10-13 have been rejected under 35 U.S.C. § 102(b) over Rava et al. (U.S. Patent No. 5,545,531, hereinafter "Rava").

The Examiner has rejected claims 2, 4-6, 8 and 10-13 under 35 U.S.C. § 102(b) as being anticipated by Rava.

According to MPEP 2131, to anticipate a claim, the reference must teach every element of the claim. According to MPEP 2112, the express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. § 102 or 103. However, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Applicants respectfully traverse the above rejections as the Examiner has failed to satisfy the above requirements.

Rava teaches probes that are on a wafer or array. Rava does not teach a solid support comprising "at least one releasable forward primer and at least one releasable reverse primer for each of said target nucleic acids adapted to be released before an amplification reaction" as

required in claim 16. The present invention requires a first solid support with at least two primers for each target nucleic acid (one releasable forward and one releasable reverse, or complements thereof), which is not expressly or inherently present in the support Rava discloses.

Furthermore, Applicants respectfully disagree with the Examiner's assertion that the probes taught by Rava are capable of being released from the support and "are necessarily adapted to be released at anytime during any process". For example, single stranded probes attached to a support to be released by a restriction enzyme can be released only after the process of forming a double stranded recognition site for the restriction enzyme and cannot be released from the support either before or during the process. Another example is an amplification process that requires specific reaction conditions that are inhibitory for releasing probes, therefore probes can be released only before or after the process.

Rava also does not teach a second solid support wherein each well corresponds to "at least one of said releasable forward primer and at least one of said releasable reverse primer". In the present invention, each well corresponds to at least two primers for each target nucleic acid (one releasable forward and one releasable reverse, or complements thereof), which is not expressly or inherently present in the support Rava discloses.

Based on the foregoing, Applicants respectfully traverse the above rejections and request its withdrawal.

B. Claims 2, 4-6, 8-13 and 15 have been rejected under 35 U.S.C. § 102(b) over Dower et al. (U.S. Patent No. 5,639,603, hereinafter "Dower").

The Examiner has rejected claims 2, 4-6, 8-13, and 15 under 35 U.S.C. § 102(b) as being anticipated by Dower.

Applicants respectfully traverse the above rejections as the Examiner has failed to satisfy the above requirements.

Dower does not teach a solid support comprising "at least one releasable forward primer and at least one releasable reverse primer for each of said target nucleic acids adapted to be released before an amplification reaction" as required in claim 16. The present invention requires a first solid support with at least two primers for each target nucleic acid (one releasable forward

and one releasable reverse, or complements thereof), which is not expressly or inherently present in the support Dower discloses.

Furthermore, Applicants respectfully disagree with the Examiner's assertion that the probes taught by Dower are capable of being released from the support and "are necessarily adapted to be released at anytime during any process". (See discussion above under Rava)

Dower also does not teach a second solid support wherein each well corresponds to "at least one of said releasable forward primer and at least one of said releasable reverse primer". In the present invention, each well corresponds to at least two primers for each target nucleic acid (one releasable forward and one releasable reverse, or complements thereof), which is not expressly or inherently present in the support Dower discloses.

Based on the foregoing, Applicants respectfully traverse the above rejections and request its withdrawal.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(A)

The Examiner has rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Rava as applied to claims 2, 4-6, 8, and 10-13 above or Dower as applied to claims 2, 4-6, 8-10, 13 and 15 above, and further in view of Monforte (U.S. Patent No. 5,700,642, hereinafter "Monforte").

According to MPEP 2143, to establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

Claim 7 is dependent on claim 16 and includes all of the limitations of claim 16. Applicants respectfully traverse the above rejection. As discussed above, neither Rava nor Dower teach a solid support comprising "at least one releasable forward primer and at least one releasable reverse primer for each of said target nucleic acids adapted to be released before an amplification reaction" as required in claim 16. Monforte does not cure the above defect, as Monforte also does

not teach a solid support with at least two primers for each target nucleic acid (one releasable forward and one releasable reverse, or complements thereof) adapted to be released before an amplification reaction.

Based on the foregoing, Applicants respectfully traverse the above rejection and request its withdrawal.

CONCLUSION

For the foregoing reasons, Applicants request the Examiner allow claims 4-13, 15 and 16 and advance the application to issuance.

FEE AUTHORIZATION

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. **23-2415** (Docket No. 28690-705.302).

Respectfully submitted,

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By:



Albert P. Halluin

Registration No. 25,227

WILSON SONSINI GOODRICH & ROSATI
650 Page Mill Road
Palo Alto, CA 94304-1050
Direct Dial: (650) 565-3585
Customer No. 21971